

REMARKS

Claims 3, 10 and 17 are pending in the above-identified application. In the current Office Action, dated May 26, 2010, (O.A.), claim 10 is rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Claims 3, 10 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Appelman et al. (U.S. Pat. Pub. No. 2004/0172454; hereinafter referred to as “Appelman”) in view of Goodman et al. (U.S. Pat. Pub. No. 2004/0003283; hereinafter referred to as “Goodman”).

Applicants submit that these amendments and remarks overcome all of the Examiner’s outstanding objections and rejections and bring the present Application into condition for allowance. Entry of this amendment and a notice of allowance of all the remaining claims are therefore respectfully solicited.

Amendments to the Title

The Title is amended to remove unnecessary references to particular types of claims. Applicants respectfully request entry of the Amendment to the Title.

Rejections Based on §101

Claims 10 is rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter, specifically because the term “computer readable medium” is broad enough to include transitory media, e.g. digital signals (p.2, line 25 through p. 3, line 7). However, claim 10 does not use the term “computer readable medium.” Claim 10 does use the term “tangible storage medium,” which is a different term. In addition, the U.S. Supreme Court has stated:

[T]here are reasons to doubt whether the [machine-or-transformation] test should be the sole criterion for determining the patentability of inventions in the Information Age...[T]he machine-or-transformation test would create uncertainty as to the patentability of software, advanced diagnostic medicine techniques, and inventions based on linear programming, data compression, and **the manipulation of digital signals**.

(*Bielski v. Kapos* (561 U.S. _____ (2010) at 9; *emphasis added*). Although not clearly stating that digital signals are statutory matter, the Supreme Court certainly does not

rule them out. However, in the interest of advancing prosecution, claim 10 has been amended to replace “tangible storage medium” to “non-transitory storage medium.” Therefore, Applicant respectfully requests withdrawal of the §101 rejection of claim 10.

Rejections Based Upon 35 U.S.C. §103(a)

Claims 3, 10 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Appelman in view of Goodman. The cited excerpt of Appelman (§[0054]), with portions relevant to the makeup of the notification archive highlighted, is as follows:

The message enhancement service 320 also may include a notification archive 345. The **notification archive** 345 may be **used to retain versions of each enhanced notification** actually provided or for which delivery was attempted but failed. The notification archive 345 **also may record with respect to each notification the device or devices to which the notification was delivered or for which delivery failed, and the dates and times of those occurrences**. In instances of failed delivery, the notification archive 345 **may store information indicative of the cause of failed delivery**, such as, for example, that a mailbox full message was received in association with an attempted email notification. The notification archive 345 may enable users, for example, to access a history of notifications for which they were an intended recipient (e.g., notifications of the last week or month) and/or to access archived versions of any past notification provided to them.

(§[0054]; *emphasis added*). In short, although Appelman suggests storing notifications in conjunction with information concerning the intended recipients, there is nothing to suggest that any information, such as an “indicator,” is stored or set in anything that could be analogized as an “address book,” “address database” or “address cache.” In other words, Appelman may store addresses within a collection of notifications but certainly does not suggest storing anything in conjunction with any of an “address book,” “address database” or “address cache.”

The O.A. concedes:

Appelman however is silent on disclosing explicitly, wherein, if said indicator, is set, said indicator is operable for clearing in response to said address becoming accessible or clearing said indicator in response to subsequently receiving an e-mail originated from the address of the addressee corresponding to the failed delivery.

(p. 4, lines 5-9). The O.A. relies upon Goodman for these particular elements however there are several deficiencies in this reliance on Goodwin. Firstly, Goodman is not manipulating “indicators” but rather sorting email into “spam” and “legitimate” folders. Secondly, Goodman is directed to the recipient of email not the sender and, therefore, is not relevant to “clearing [said indicator] in response to said address becoming accessible” because the recipient’s address must be accessible to have received the email in the first place. Thirdly, Goodman is primarily directed to the prevention of unsolicited email, or “spam,” by using a “challenge.” There is no “subsequently receiving” or “failed delivery” because the spam has already been received by the recipient. In fact, all of Goodman’s processing is after an email has been received.

The O.A. also states:

Therefore, it would have been obvious to one of ordinary skilled in the art at the time the invention was made to combine the teachings of Appleman with the teaching of Goodman in order to provide a system in addition to calculate the probabilities of legitimate email, such as the score form a Support Vector Machine, a Neural network, etc. can serve the same purposes as probabilities – in general, the numeric output of any machine learning algorithm can be used in place of a probability in accordance with an aspect of the present invention. Similarly, some machine learning algorithms, such as decision trees, output categorical information, and this too can be used in place of a probability combined with threshold.

(p. 5, lines 6-14). Although I have read this excerpt multiple times, I am unable to determine the relevance to the claimed subject matter. In fact, there are no claims

directed to “calculating probabilities,” “machine learning algorithms,” “probability combined with threshold,” etc.

The Examiner has simply not offered any explanation why it would be reasonable for one of ordinary skill in the art would further modify the teachings of Applemen or Goldman to apply to setting indications in conjunction with an (actions which are not taught, suggested or otherwise contemplated by either of the references' teachings) as claimed by Appellants. Consequently, the Examiner has failed to establish a *prima facie* case of obviousness under either the TSM test applied at the time of the FOA or under the broader obviousness test established in *Graham vs. John Deere* and affirmed in *KSR vs. Teleflex*."

"The identical invention must be shown in as complete detail as is contained in the claim." (MPEP §2131, citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). The elements must be arranged as required by the claim ... (MPEP §2131, citing *In re Bond*, 910 F.2d 831, (Fed. Cir. 1990)). In addition, to establish *prima facie* obviousness of a claimed invention under §103(a), all the claim limitations must be taught or suggested by the prior art. (M.P.E.P., §2143.03, citing *in re Royka*, 490 F.2d 981; 180 U.S.P.Q. 580 (CCPA 1974)). In addition, "**All words in a claim must be considered** in judging the patentability of that claim against prior art." (*Id.*, citing *In re Wilson*, 424 F.2d 1382, 1385; 165 U.S.P.Q. 494, 496 (CCPA 1970); *emphasis added*). Applicants believe that the cited art fails to meet this standard. For the reasons above, claims 3, 10 and 17 are allowable over the cited art. Therefore, Applicants respectfully request withdrawal of the §103(a) rejections of claims 3, 10 and 17.

CONCLUSION

In light of the amendments and remarks made herein, Applicants submit that all pending claims are allowable and earnestly solicits notice thereof. Applicants are not conceding in this application that the unamended claims are not patentable over the art cited by the Examiner, as the present claim amendments are only for facilitating expeditious prosecution of the allowable subject matter. Applicants respectfully reserve the right to pursue these and other claims in one or more continuation and/or divisional patent applications. A Request for a One-Month Extension of Time to file this Amendment by January 26, 2008 is being filed and paid for concurrently with this filing. It is believed that no other fees are due with the filing of this Amendment/Response. However, should any other fees be due, the Commissioner is hereby authorized to charge such fees to the deposit account of IBM Corporation, Deposit Account No. 09-0447.

Respectfully submitted,

Date: August 26, 2010

/Gregory K. Goshorn/

By: Gregory K. Goshorn

Reg. No.: 44,721

ATTORNEY FOR APPLICANT

Greg Goshorn, P.C.
9600 Escarpment
Suite 745-9
Austin, Texas 78749
Telephone: (512) 291-9203
Facsimile: (512) 535-4206